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In re Application of  
Komori et al.  
Application No. 10/576,496  
PCT No.: PCT/JP2004/015879  
Int. Filing Date: 20 October 2004  
Priority Date: 20 October 2003  
Atty. Docket No.: Q94468  
For: Bone And/Or Joint Disease-Associated  
Genes

DECISION

This is in response to applicants' "Petition Under 37 C.F.R. § 1.182..." filed on 19 December 2006.

### **BACKGROUND**

This international application was filed on 20 October 2004, claimed an earliest priority date of 20 October 2003, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 20 April 2006. Applicants filed, *inter alia*, the basic national fee on 20 April 2006. Subsequently, petitioner's deposit account was debited for excess claim fees.

### **DISCUSSION**

A review of international application PCT/JP2004/015879 reveals that 40 claims appeared in the published international application. On 13 September 2006, applicants filed a preliminary amendment whose entry resulted in 93 claims being present in the case. Petitioner filed another ("second") preliminary amendment on 27 October 2006 (after the mailing of a Notice of Acceptance on 26 October 2006) reducing the number of claims to 24. MPEP 1893.01(c) states in relevant part that

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492\*\*>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492\*>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608. (Emphasis added.)

Petitioner states that the second preliminary amendment was filed based on the oral

suggestion of a USPTO employee.<sup>1</sup> Although applicant may have sought to reduce the number of claims for examination prior to calculation and processing of the fees, the second preliminary amendment was not filed until after the fees had been calculated and charged. Therefore, as a "subsequently filed amendment" filed subsequent to payment of the fees, the later-filed second preliminary amendment of 27 October 2006 does not entitle applicant to a refund of the previously paid excess claim fees. *See* 37 CFR 1.26 ("A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee"). The petition fails to make a sufficient showing that a miscarriage of justice would occur if the Office adheres to the requirement plainly set forth in MPEP 1893.01(c) and noted above.

### **DECISION**

The petition is **DISMISSED**, without prejudice, for the reasons discussed above.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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<sup>1</sup>See 37 CFR 1.2 ("No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt").

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